

REMARKS

The Applicants understand that the Board of Patent Appeals and Interferences have decided that the previous appeal was affirmed-in-part, vacated-in-part and a new ground of rejection was entered. Claims 22-25 and 27-37 are currently pending to which the Board has presented two rejections:

- I. Claims 22-25 and 27 are rejected under 35 USC § 103(a) as allegedly unpatentable under Gosselin et al. (designated as a new ground of rejection as per 37 CFR § 41.50(b)).

- II. Claims 28-37 are rejected under 35 USC § 112 ¶ 2 as allegedly being indefinite.

I. Claims 22-25 and 27 Are Not Obvious

The Board decided that:

Although the '059 Application does not specifically recite that the liquid vehicle is sterile, we agree with the Examiner that using a sterile liquid vehicle for a therapeutic solution would have been obvious.

BPAI Decision, pg 6 May 30, 2007. The BPAI relied upon a *KSR v. Teleflex* quotation “The combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results”. The Applicants disagree because Gosselin et al. provides no teachings regarding “a therapeutic solution”. Gosselin et al. teaches an alleged sterile solution containing many components (i.e., for example, RPMI cell culture media¹, fetal calf serum, infectious Epstein Barr Virus, and peripheral blood mononuclear cells)². These components are not ones which one having ordinary skill in the art would consider advantageous for “a therapeutic solution”.

Nonetheless, without acquiescing to the Examiner's argument but to further the prosecution, and hereby expressly reserving the right to prosecute the original (or similar) claims, Applicants have amended Claim 22 to recite a solution “consisting of a sterile

¹ RPMI contains a variety of salts, growth factors, and amino acids.

² Gosselin et al., '059 Application, pg. 13.

normal saline vehicle". *Applicant's Specification pg 9 ln 1.* This amendment is made not to acquiesce to the Examiner's argument but only to further the Applicants' business interests, better define one embodiment and expedite the prosecution of this application.

The Examiner should realize that the now closed nature of Claim 22 is not obvious in view of Gosselin et al. The Applicants respectfully request that the Examiner withdraw the Obviousness rejection.

II. Claims 28-37 Are Not Indefinite

The Board decided that:

Here, it is unclear whether claims 28 and 33 are directed to a "solution," as recited in the preamble, or whether infringement would require the use and sale of the combination of a solution and a nebulizer or endotracheal tube.

BPAI Decision, pg 9(May 30, 2007). The Applicants disagree. Nonetheless, without acquiescing to the Examiner's argument but to further the prosecution, and hereby expressly reserving the right to prosecute the original (or similar) claims, Applicants have amended Claims 28 and 33 to recite "An article of manufacture".³ This amendment is made not to acquiesce to the Examiner's argument but only to further the Applicants' business interests, better define one embodiment and expedite the prosecution of this application. The Applicants argue that the Examiner has not provided any references sufficient to meet the Board's challenge:

If the claims are amended so that they clearly claim an article of manufacture, any rejection would of course need to address the limitation reciting the nebulizer, endotracheal tube, etc. containing the solution.

BPAI Decision, pg 10 (May 30, 2007). The Applicants respectfully request that the Examiner withdraw the Indefiniteness rejection.

³ This amendment confers patentable weight to the "wherein clause" (*BPAI Decision, pg 9*).

CONCLUSION

The Applicants believe that the arguments and claim amendments set forth above traverse the Examiner's rejections and, therefore, request that all grounds for rejection be withdrawn for the reasons set above. Should the Examiner believe that a telephone interview would aid in the prosecution of this application, the Applicants encourage the Examiner to call the undersigned collect at 617.984.0616.

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